REMARKS

Applicants thank the Examiner for the very thorough consideration given the present application.

Claims 1-39 are now present in this application. Claims 1, 11, 15, 19, 23, 26, 29 and 32 are independent.

Reconsideration of this application is respectfully requested.

Rejections under 35 U.S.C. §103

Claims 1-4, 8-9, 11, 13 and 36-38 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,470,378 to Tracton et al. (hereinafter, "Tracton") in view of U.S. Patent 5,444,707 to Cerna et al. (hereinafter, "Cerna").

Claims 15-26 and 29-30 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,263,503 to Margulis in view of Cerna.

Claims 5-7, 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tracton in view of Cerna and further in view of U.S. Patent 6,263,503 to Margulis.

Claim 10 is rejected under 35 U.S.C. §103(a) as being unpatentable over Tracton in view of Cerna and further in view of U.S. Patent No. 6,246,430 to Peters et al. (hereinafter, "Peters").

Claims 31-39 are rejected under 35 U.S.C. §103(a) as being unpatentable over Margulis in view of Cerna and further in view of Tracton.

Claims 27 and 28 are rejected under 35 U.S.C. §103(a) as being unpatentable over Margulis in view of Cerna and further in view of Peters.

These rejections are respectfully traversed.

Claims 1-4, 8-9, 11, 13 and 36-38:

The rejections which use Tracton as a base reference are discussed first. Tracton is used as the base reference in the rejections of claims 1-14, and 36-38.

A complete discussion of the Examiner's rejections of claims 1-14 and 36-38 is set forth in the Office Action, and is not being repeated here.

The Office Action points out that Tracton discloses a server capable of scaling source content according to network speed , referencing col., 5, lines 58-62. The Office Action concludes that this disclosure "reads on the claimed controlling unit for varying an encoding rate." Applicants strenuously disagree with this conclusion. In this regard, claim 1, for example, recites "a controlling unit for varying an encoding rate of the video signals and a transmission bandwidth of the video signals in accordance with telephone call quantity information" (emphasis added).

Tracton is mainly concerned with the internet as it existed in 1999, when its application was filed. Tracton only briefly mentions that "one can easily support other architectures, such as text-only pagers or cellular phone based browsers." There is no disclosure in Tracton that the briefly referenced "text only pagers" or "cellular phone based browsers" are contemplated to be used with telephone call (voice) quantity information, as recited. Note that Tracton does not disclose a cellular telephone, per se. All that is disclosed is a "browser" that is "cellular telephone based." There is no reason why such a browser is actually a cellular telephone. It may just be a browser that works on a cellular telephone network.

What appears to be happening here is improper hindsight reconstruction of Applicants' invention using Applicants' disclosure instead of just using Tracton's disclosure.

Tracton is concerned with web page content, and never mentions that it is interested in telephone calls.

The interest in telephone calls is only found in Applicants' disclosure, which cannot properly be used as the basis for a rejection of Applicants' claims.

The Office Action does admit that what is not disclosed by Traction "is varying an encoding rate and transmission bandwidth in accordance with telephone call quality information." Unfortunately, this statement is not completely accurate. What is actually claimed, and is totally missing from Tracton, is "a controlling unit for varying an encoding rate of the video signals and a transmission bandwidth of the video signals in accordance with telephone call quantity information."

In an attempt to remedy this deficiency, the Office Action turns to Cerna, which is directed to a multi-channel telephone system using telephone lines.

Cerna discloses a multi-channel telephone line system that switches packetized information from a source node based on the digits dialed. Cerna has a packet switching unit that reads the digits dialed at the source node and determines whether there is sufficient bandwidth for communication over the requested connection to occur. If there is sufficient bandwidth; a connecting=n is requested to the desired destination node and, if accepted, communication begins. See col. 3, lines 22-29. Cerna uses flow control to dynamically adjust the communications bandwidth, sacrificing voice quality when necessary and increasing voice quality when possible. See col. 3, lines 22-29 and col.7, lines 43-68. If, for example, the bandwidth needed by the current traffic exceeds the available bandwidth, the compression factor applied by the source RLX is

increased, resulting in a reduced bandwidth requirement. See col. 8, lines 3-24.

Cerna contains no disclosure whatsoever about transmitting video and audio signals from motion picture information, or of varying an encoding rate of the video signals and a transmission bandwidth of those signals in accordance with telephone call quantity information.

The only disclosure of record that has such a teaching is Applicants' disclosure. It is apparent that this rejection is using impermissible hindsight reconstruction of Applicants' invention as the basis for this rejection. That is not proper.

The Office Action concludes that in view of Cerna's disclosure, one of ordinary skill in the art would recognize the benefits of using telephone call quantity information to vary transmission bandwidth in a packet switching telephone network. This is nothing more than a broad conclusionary statement about a reference that does not constitute evidence of proper motivation to modify Tracton on view of Cerna. . See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

Furthermore, Applicants disagree with this conclusion. Cerna's disclosure is in terms of "voice quality" information – see col. 7, lines 66-68 and col. 8, line 1, not "telephone call quantity" information, as recited.

Based on this incorrect conclusion, the Office Action further concludes that "it would be obvious to modify the invention of Tracton with the telephone call quantity information of Cerna to maximize the number of connections a single trunk line can support and minimze cost."

This conclusion is flawed not only because Cerna focuses on "voice quality" information instead of "telephone call quantity" information, but also because the claimed invention has nothing to do with telephone trunk lines or minimizing the cost of telephone trunk lines.

Applicants respectfully submit that there is no objective evidence presented in the Office Action that would provide proper motivation to one of ordinary skill in the art to modify Tracton's meagerly disclosed cellular phone based browser directed to displaying web pages and has no disclosure of simultaneous use of a cellular telephone based browser as a web based browser and a telephone calling device in view of a telephone trunk line system that discloses sacrificing voice quality to be able to use only one trunk line.

The only reason this unsuitable combination of references is being made is solely because of Applicants' disclosure.

Moreover, neither Cerna nor Tracton contains any disclosure whatsoever about transmitting video and audio signals from motion picture information along with telephone calls, or of varying an encoding rate of the video signals and a transmission bandwidth of those signals in accordance with telephone call

quantity information, as recited.

So, even if these references were properly combinable, which they are not at least for reasons stated above, the resulting reference combination would not render the claimed invention obvious.

Claims 2-4, 8, 9 and 36 depend from claim 1 and contain all the features of claim 1. Accordingly, claims 2-4, 8, 9 and 36 are patentable over Tracton in view of Cerna at least for the reasons that claim 1 is patentable over that reference combination.

With respect to claims 11, 13 and 37, these claims recite that the mobile communication terminal does the decoding of the video signal at a rate which varies in accordance with a voice telephone call quantity information. This is the opposite of what Tracton and Cerna focus on. Tracton and Cerna focus on coding the original source content, not on decoding it at a particular rate. This is another reason why the proposed reference combination is improper and would not render the claimed invention obvious.

Moreover, the rejection does not even address these features as they are recited in claims 11, 13 and 37.

Accordingly the rejection of claims 1-4, 8-9, 11, 13 and 36-38 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Tracton in view of Cerna is improper and should be withdrawn

Claims 5-7, 12 and 14:

Claims 5-7, 12 and 14 are rejected under 35 U.S.C. §103(a) as being unpatentable over Tracton in view of Cerna and further in view of U.S. Patent 6,263,503 to Margulis.

Applicants respectfully submit that Tracton and Cerna do not render obvious the claimed invention recited in claim 1, form which claims 5-7 depend, and claim 11, from which claims 12 and 14 depend, and, accordingly, they do not render obvious the subject matter of claims 5-7, 12 and 14.

Moreover, Margulis is not applied to remedy the deficiencies of Tracton and Cerna, which are pointed out above.

Margulis is cited to disclose a wireless television system that accepts a variety of inputs, including analog video and audio, which are processed into a format compatible with a wireless client.

The Office Action alleges it would be obvious to combine Margulis with the system of Tracton modified by Cerna in order to support a wide variety of broadcast A/V formats in a wireless television system.

Applicants respectfully submit that even if these references were properly combines, which they are not for reasons discussed below, the resulting reference combination would not result in the claimed invention which simply is not rendered obvious by Tracton and Cerna for reasons discussed above.

Furthermore, neither Tracton nor Cerna disclose wireless television systems. Tracton discloses an internet web page based system and Cerna discloses a trunked telephone system. The only possible reason for combining these references is improper hindsight reconstruction of the invention based solely on Applicants' disclosure.

Accordingly, this rejection fails to make out a prima facie case of obviousness of the invention recited in claims 5-7, 12 and 14, and should be withdrawn.

Claim 10:

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tracton in view of Cerna and further in view of U.S. Patent No. 6,246,430 to Peters et al. (hereinafter, "Peters").

Applicants respectfully submit that Tracton and Cerna do not render obvious the claimed invention recited in claim 1, form which claims 5-7 depend, and claim 11, from which claims 12 and 14 depend, and, accordingly, they do not render obvious the subject matter of claims 5-7, 12 and 14.

Moreover, Peters is not applied to remedy the deficiencies of Tracton and Cerna, which are pointed out above.

Adding Peters is an improper stretch because neither Tracton nor Cerna disclose or suggest an interactive video service. This rejection is based wholly

on hindsight reconstruction of Applicants' invention based solely on Applicants' disclosure.

Accordingly, this rejection fails to make out a prima facie case of obviousness of the invention recited in claim 10, and should be withdrawn.

Claims 15-26, 29 and 30:

Claims 15-26 and 29-30 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,263,503 to Margulis in view of Cerna.

Margulis admittedly does not disclose an encoding rate of the video signals and a transmission rate of a mobile communications network varied in accordance with a voice telephone call quality information. Applicants note that this deficiency exists in Margulis despite the fact that Margulis discloses that a user may receive a telephone communication via remote TV 158 while simultaneously viewing a caller ID display or may similarly use the wireless TV system to interact with an Internet browser program, without any mention of using the claimed invention.

If the claimed invention were so obvious, then why didn't Margulis think of and disclose it?

The Office Action mischaracterizes Cerna, alleging that Cerna provides evidence that ordinary workers in the art would recognize the benefits of using telephone call quantity information to vary transmission bandwidth in a packet

switching network. This is not so, for reasons pointed out above, which include the fact that Cerna focuses on voice quality, not telephone call quantity.

The Office Action then concludes that it would be obvious to modify Margulis with the telephone call quantity information of Cerna to maximize the number of connections of a single trunk line can support and minimize cost.

This conclusion is incorrect because of the aforementioned deficiencies of Cerna and because the Office Action does not provide a proper motivation to combine these two references

Neither Margulis nor Cerna disclose mobile wireless television systems. Margulis discloses a wireless TV system and Cerna discloses a trunked telephone system. The only possible reason for combining these references is improper hindsight reconstruction of the invention based solely on Applicants' disclosure.

It is well settled that a rejection based on 35 USC §103 should deal with the invention as a whole and that it must consider the differences between the prior art and the claimed invention. Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966). These significant differences between these references would mitigate against combining these two references.

Accordingly, this rejection fails to make out a *prima facie* case of obviousness of the invention recited in claims 15-26, 29 and 30, and should be withdrawn.

Claims 31-39:

Claims 31-39 are rejected under 35 U.S.C. §103(a) as being unpatentable over Margulis in view of Cerna and further in view of Tracton.

Regarding claim 31, this rejection is improper because the rejection of claim 29 over Margulis and Cerna, on which claim 31 depends, in improper for reasons stated above. Moreover, Traction does not remedy the deficiencies of Margulis and Cerna. Furthermore, there is no proper motivation given to combine Tracton with Margulis and Cerna. Tracton is concerned with a web page server that marginally mentions using a cellular telephone based browser (it does not disclose that this is a cellular telephone, per se, or is used as a cellular telephone when it is used as a web browser). Tracton's disclosure of MPEG-4's bit rate is disclosed in connection with low-speed wired networks. This teaching is nothing more than a general teaching that lacks the particularity and clarity needed to motivate a skilled worker to use MPEG-4 in Margulis' system or the improperly combined Margulis-Cerna system. Such broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence" of proper motivation to combine particular references in specific ways. See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

With respect to claims 32-35, this rejection is improper because the rejection of claim 29 over Margulis and Cerna, on which claim 31 depends, in

improper for reasons stated above. Moreover, Traction does not remedy the deficiencies of Margulis and Cerna. Furthermore, Tracton only discloses a cellular telephone based browser. Applicants respectfully submit that the Office Action is stretching Tracton beyond its disclosure to allege that Tracton discloses operating a cellular telephone and using a cellular telephone based browser in general, let alone to the extent that Tracton would vary the broadcast signal in accordance with telephone call quantity information alone or even, as claimed, along with a transmission rate of a mobile communication network. Moreover, Tracton does not disclose wireless broadcast television as does Margulis. This is another significant difference between these references, which would mitigate against motivation to combine them.

The only reason that these references are being combined is because of improper hindsight reconstruction of Applicants' invention based solely on Applicants' disclosure.

Furthermore, claims 32-35 claims recite that the mobile communication terminal does the decoding of the video signal at a rate which varies in accordance with a voice telephone call quantity information. This is the opposite of what Cerna focuses on. Cerna focuses on coding the original source content, not on decoding it at a particular rate. Thus, this is another reason that the proposed reference combination would not render the claimed invention obvious. Also, these recited features are not addressed, as such, in this rejection.

Regarding claim 39, which depends from claim 19, this rejection is improper because the rejection of claim 19 over Margulis and Cerna, on which claim 39 depends, is improper for reasons stated above. Moreover, Traction does not remedy the deficiencies of Margulis and Cerna. Furthermore, there is no objective evidence presented that would motivate one of ordinary skill in the art to further combine Tracton with Margulis and Cerna. As noted above, Tracton does not disclose wireless broadcast television as does Margulis.

Accordingly, this rejection of claims 31-39 is improper and should be withdrawn.

Claims 27 and 28:

Claims 27 and 28 are rejected under 35 U.S.C. §103(a) as being unpatentable over Margulis in view of Cerna and further in view of Peters.

Claims 27 and 28 depend from claim 26, which is allowable over Margulis and Cerna for reasons stated above. Moreover, Peters does not remedy any of the aforementioned defects in the Margulis-Cerna reference combination.

Adding Peters is an improper stretch because neither Margulis nor Cerna disclose or suggest an interactive video service. This rejection is based wholly on hindsight reconstruction of Applicants' invention based solely on Applicants' disclosure.

Accordingly, this rejection fails to make out a *prima facie* case of obviousness of the invention recited in claims 27 and 28, and should be withdrawn.

For the aforementioned reasons, Applicants respectfully submit that claims 1-39 are patentable and should be allowed.

Additional Cited References

Since the remaining references cited by the Examiner have not been utilized to reject the claims, but have merely been cited to show the state of the art, no comment need be made with respect thereto.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46,472, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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